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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,035	10/01/2001	Toshihiro Hamamura	018656-251	4858

7590 05/03/2005

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EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/967,035

Applicant(s)

HAMAMURA ET AL.

Examiner

James A. Kramer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 10-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Claim Objections***

Claims 1-2, 10-18 are objected to because of the following reasons: Applicant's use of the determiner "the" before certain limitations adds confusion to the claims.

For example, Claim 1, lines 7-10 recites, "a controller that reads the image data recorded on the medium, causes the printer to perform printing in response to the order via the instructing unit, receives the printing fee, and updates the prepaid balance in the prepayment information of the medium after the printing instruction is issued from the instructing unit (emphasis added to the specific errors)."

The claim lacks antecedent basis for the printing fee, the prepaid balance, the prepayment information or the printing instruction. The determinant "the" used before nouns or noun phrases designates a particular person or thing (Webster's II New Riverside Dictionary). As such, Examiner asserts that it is confusing to call out "particular" things (e.g. the printing fee, the prepaid balance, the prepayment information and the printing instruction) when they have not been previously defined in the claim.

Examiner suggests defining the terms in the claims prior to the cited recitations or replacing the determiner "the" and with the indefinite article "a".

Also reference:

Claim 1	<ul style="list-style-type: none">• "the user" on line 4
Claim 10	<ul style="list-style-type: none">• "the user" on line 4• "the prepaid balance" on lines 7 and 8
Claim 12	<ul style="list-style-type: none">• "the user" on line 4• "the fee" on line 7

	<ul style="list-style-type: none"> • “the prepaid balance” on lines 7 and 9
Claim 13	<ul style="list-style-type: none"> • “the user” on line 4 • “the fee” on line 8 • “the prepaid balance” on lines 9 and 10 • “the printing fee” on line 9 • “the cash” on line 10
Claim 14	<ul style="list-style-type: none"> • “the user” on line 4 • “the fee” on line 8 • “the prepaid balance” on lines 9 – 10 • “the cash” on line 11
Claim 15	<ul style="list-style-type: none"> • “the user” on line 4 • “the fee” on line 7 • “the prepaid balance” on lines 7-8 • “the prepayment information” on line 8
Claim 16	<ul style="list-style-type: none"> • “the user” on line 4 • “the fee” on line 7 • “the prepaid balance” on lines 7-8 • “the printing fee” on line 8 • “the printing history” on line 9
Claim 17	<ul style="list-style-type: none"> • “the user” line 3 • “the printing history” on lines 7 and 8 • “the prepaid balance” on line 9
Claim 18	<ul style="list-style-type: none"> • “the user” on line 5 • “the prepaid balance” on line 8 • “the prepayment information” on line 8

Examiner further notes that claim 1 recites the limitation, “an instructing means by which the user places an order for printing regarding the images recorded on the storage medium.”

Art Unit: 3627

There is no antecedent basis for “the images.” However, Examiner notes that one of ordinary skill in the art, upon review of the Specification and the claims in their entirety would reasonably recognize that Applicant is referring to the “image data” recorded on the medium.

Examiner respectfully suggests that Applicant replace “the images” with “the image data” in order to reduce the confusion. Also reference claims 10-18, which have the same recitation of “the images” and for which Examiner suggests similar correction.

Examiner also notes that claim 14 recites “updates the prepaid balance and updates the prepaid balance of the storage medium” on lines 9-10. Examiner notes that the first “updates prepaid balance” appears to be a typographical error. Examiner suggests removing it to clarify the claim.

Examiner also notes that claim 15 recites “the information” on lines 8-9. Examiner notes that the claim contains several limitations that might be considered information that should be displayed. In light of the numerous errors as a result of the use of the determiner “the”, Examiner finds the broadness of “the information” confusing.

However, as the claim includes only one specific recitation of “information” (e.g. “the prepayment information”) Examiner finds that one of ordinary skill in the art would reasonably know that “the information” refers to “prepayment the information”. Regardless, Examiner respectfully suggests replacing “the information” with “the prepayment information” in order to avoid confusion and clarify the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the following limitation on lines 8-10, "recording the prepaid balance on the storage medium is updated according to the user orders printing of the images recorded on the storage medium."

Examiner notes that it appears Applicant intends to update the prepaid balance on the storage medium based on the printing orders placed by the user. This is how the claim will be interpreted in this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of .

Cook et al. teaches a method and system for self-service film processing that includes a mounting mechanism that mounts a medium having a prepay function (column 5, line 8 through column 6, line 3).

Art Unit: 3627

Cook et al. further teaches a mounting mechanism which mounts a medium on which image data is recorded (column 6, lines 28-34 and column 6, line 62 through column 7, line 2).

Cook et al. teaches an instructing unit by which the user places an order for printing with regard to the image data recorded on the medium (column 6, lines 4 – 27).

Cook et al. further teaches a printer that prints images recorded on the medium (column 8, lines 33-47)

Cook et al. further teaches a controller that

- reads the image data recorded on the medium (column 6, lines 63-65)
- causes the printer to perform printing in response to the order via the instructing unit (column 7, lines 30-33 and column 8, lines 33-47),
- receives the printing fee, and updates the prepaid balance in the prepayment information of the medium after the printing instruction is issued from the instructing unit (column 5, lines 49-53).

Cook et al. teaches that the controller accepts a printing instruction after the image data is read from the medium (column 6, lines 8-12). Examiner notes that for the customer to make decisions regarding the digital images (such as printing) the images must first have been read by the system (controller).

Cook et al. does not teach that the image data and the prepay function are on the same medium.

Levy et al. teaches a film processing system and method including a feature in which a prepay function is placed on a medium with image data (column 3, lines 17-25). Levy et al. further teaches that this is done in order to provide enhanced and quicker operation for a consumer.

Art Unit: 3627

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the medium on which image data is recorded of Cook et al. and the medium having a prepay function of Cook et al. by combining them into one medium as taught by Levy et al. One of ordinary skill in the art would have been motivated to modify the references in order to provide the consumers with enhanced and quicker operation.

Cook et al. further teaches the controller causing the printing of a receipt (column 5, line 23-25). Cook et al. does not teach that the receipt contains the prepaid balance. Examiner takes Official Notice that it's old and well known in the art to include payment information on a receipt in order to provide a user with a complete detail of a transaction. Further, Examiner points out that Cook et al. teaches that payment information includes prepaid balance (column 5, lines 49-53).

As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include payment information including prepaid balance on the receipt of Cook et al. in order to provide the consumers with a complete detail of the transaction.

Cook et al. does not specifically teach a mounting mechanism that prevents removal of the medium until updating of the prepaid balance is complete and nullifies the printing order if the storage medium is removed before the prepaid balance is updated.

The Examiner takes Official Notice that it's old and well known in the art for kiosks to include mechanisms to prevent the removal of medium containing prepaid data to be removed prior to updating the data and to nullify the transaction in the case where the medium is removed.

Art Unit: 3627

By way of example, Examiner offers an ATM machine that takes the user's card and does not return it until after the transaction is complete. Further, Examiner notes that this is done in order to prevent damage to the medium as well as to insure that the transaction is properly completed and recorded.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Cook et al. to include a mechanism which prevents the removal of the medium until the prepaid balance is updated and that nullifies the transaction if the medium is removed prematurely. One of ordinary skill in the art would have been motivated to modify the reference in order to prevent any damage to the medium as well as to ensure that the transaction is properly complete and recorded.

Cook et al teaches a money receiving means (column 5, lines 14-16). Further, Cook et al. teaches increasing the value of a card via the input of monies (column 5, lines 53-58). Examiner notes that these teaching render obvious updating the prepaid balance and settling the printing fee by combining the prepaid balance in the storage medium and the cash added using money receiving means.

Cook et al. teaches the prepaid card also includes customer information which aids in marketing activities such as promotional activities (column 5, lines 60-65). However, Cook et al. does not specifically teach calculating fees in accordance with printing history.

Examiner takes Official Notices that proving discounted prices for bulk purchases is an old and well known promotional activity. Further, providing discount prices based on bulk

Art Unit: 3627

purchases represents a calculating a price based on purchasing history (i.e. buying a lot of an item). One of ordinary skill in the art would recognize that discounts for bulk purchases are used to generate additional business and reward customer loyalty.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the promotional activities based on customer information of Cook et al. to include providing discounted prices for bulk purchases (calculate the printing fee in accordance with printing history). One of ordinary skill in the art would have been motivated to combine these references in order to generate additional business and reward customer loyalty.

Conclusion

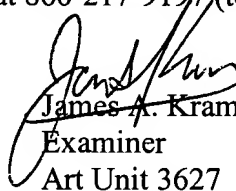
Examiner notes that the Official Notice statements made in this Office Action are in accordance with MPEP 2144.03. In particular, the facts so noticed are of notorious character and serve only to, "fill in the gaps" which exist in the evidentiary showing made by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272 6777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James A. Kramer
Examiner
Art Unit 3627

4/27/05

jak